

REMARKS

This submission is in response to the Office Action, mailed January 23, 2003. Applicants respectfully request entrance of the above claim amendments, presented in revised format. Applicants respectfully submit that the above claim amendments even more clearly bring the claims into a condition for allowance and, as such, are appropriate for an after-Final Office Action entrance into the application, in accordance with 37 C.F.R. § 1.116. No new matter is entered by the amendments. Basis for the amendments to claim 19 may be found, at least, in the specification at page 6, lines 4 and 25-27 and in original claim 11. Basis for new claim 33 may be found, at least, in original claims 8, 9, and 13.

As a preliminary matter, Applicants respectfully submit that the issuance of a Final Office Action is improper and contrary to present patent practice and procedure. MPEP § 706.07(a) states that:

Under present practice, second or any subsequent actions on the merits shall be final, *except* where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

(emphasis added). The Office Action, in paragraph 4, states that, "The following are new grounds of rejection." Applicants have neither amended the claims in Applicants' submission, nor have Applicants submitted an information disclosure statement during the period set forth in 37 CFR 1.97(c). Therefore, these new grounds of rejection cannot be "necessitated by applicant's amendment of the claims" or "based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c)." Thus, Applicants respectfully submit that the new grounds of rejection in the Office Action preclude the issuance of a Final Office Action.

With regard to the rejections in the Office Action, the Office Action states that claims 19-20 and 30-32 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by U.S. Patent No. 3,678,149 ("the '149 Patent"). Specifically, the Office Action states that the '149 Patent discloses mannitan oleate used in vaccines and, thus, anticipates the present claims. However, the use of mannitan oleate is clearly distinguished from the claims of the present invention. The present invention does not involve mannitan oleate. Rather, the present invention involves *polyethoxylated* mannitan oleate. This is a different compound that is distinguished from simple mannitan oleate. In fact, mannitan oleate is one of the reference

compounds utilized as a comparison to demonstrate the advantages and benefits of the present invention (See page 10, reference 2: mannitan oleate (HLB = 3.3)). Further, with regard to the claim language, the claims recite a vaccine with a surfactant having a HLB number of at least 5 and of at most 15. Therefore, mannitan oleate is clearly outside the scope of the recited subject matter.

The Office Action states that claims 19-20 and 30-32 are rejected under 35 U.S.C. § 102(b) as being allegedly anticipated by Perlaza et al. (1998). Specifically, the Office Action states that Perlaza et al. discloses mannitan oleate. As discussed with regard to the '149 Patent, the present invention is clearly distinguished and is not anticipated by a disclosure of mannitan oleate in vaccines.

The Office Action states that claims 19-20 and 30-32 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Upon entrance of the above claim amendments, Applicants respectfully submit that claim 19--and the claims dependent therefrom--even more clearly particularly point out and distinctly claim the subject matter of the present invention. As such, Applicants respectfully submit that the rejections under 35 U.S.C. § 112, second paragraph, are obviated by the above claim amendments.

Applicants respectfully request an indication of allowance of all claims for the reasons set forth above. In the event that any issues remain outstanding in the application, Applicants would appreciate the courtesy of a telephone call to the undersigned counsel to resolve such issues in an expeditious manner and place the application in condition for allowance.

Respectfully submitted,

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